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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: FORD, GARRETT N.

DOCKET NO.: 122142.00009

SERIAL NO.: 10/755,984

FILED: 01/13/2004

EXAMINER: NGUYEN, SON T.

ART UNIT: 3643

TITLE: HORSE BOOT WITH DUAL TONGUE ENTRY SYSTEM

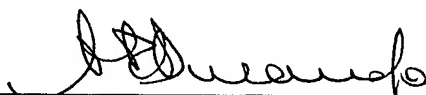
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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CERTIFICATE OF TRANSMISSION

I hereby certify that on this 23rd day of August, 2006, this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with courtesy copy transmitted via facsimile (571-273-8300) to the United States Patent and Trademark Office, Attn: Examiner Son T. Nguyen, Art Unit 3643.

By: _____


Antonio R. Durando

PETITION TO THE OFFICE OF THE DEPUTY COMMISSIONER FOR PATENT
EXAMINATION POLICY

FOR REVIEW OF A DECISION OF THE TECHNOLOGY CENTER DIRECTOR
UNDER 37 C.F.R. 1.181

Dear Sir:

This is a Petition under 37 C.F.R. 1.181 and MPEP Sect. 1002.02(b) seeking review of a decision of the Technology Center Director on

the applicant's petition to withdraw the finality of a rejection in the above-captioned case. Pursuant to 37 C.F.R. 1.181(d) and MPEP Sect. 1002.02(b), no fee is believed to be due with this Petition. If a petition fee is nonetheless due, please charge it to Deposit Account No. 04-1935.

An appeal of this case is currently pending. The applicant's brief was filed on June 19, 2006.

The issue of prematurity of the final rejection was first raised with the Examiner pursuant to MPEP Sect. 706.07(c) in a Request for Reconsideration filed on March 10, 2006. The Examiner maintained the finality of the rejection by Advisory Action dated March 20, 2006. The applicant filed a Petition to the Director for review of the Examiner's decision on May 5, 2006, and the Decision denying the Petition issued on July 21, 2006. This Petition seeks review of that Decision.

Inasmuch as the applicant believes that the Director's Decision did not address, other than in a cursory and non-responsive manner, the issues raised in the initial Petition, much of the same arguments is used in the discussion below. To the extent that the Deputy Commissioner may agree with the Technology Center Director on any of the issues raised by this Petition for Review, the undersigned

would greatly appreciate a substantive explanation of the basis for such agreement, so that the undersigned and other members of the Patent Bar who have been involved in this issue, including some ex-patent examiners, may have the benefit of understanding how the PTO currently interprets the MPEP sections in question. As interpreted by the Technology Center Director, the exceptions provided to the requirement for final actions appear to have no practical bearing on the practice.

HISTORY OF RELEVANT FACTS TO THE CASE

The case was filed on January 13, 2004, with 19 claims, of which Claims 1 and 18 are independent claims. Both independent Claims 1 and 18 were rejected as anticipated by Dallmer (US 4,744,422) and Kos (US 2,986,823) in a first non-final action dated February 24, 2005.

In reply to the first action, the applicant amended both Claims 1 and 18, and added two new dependent claims. In particular, Claim 18 was amended as follows (only this claim is relevant to the review sought by the applicant):

"18. (currently amended) An article of footwear for ~~an~~ a hoofed animal comprising:

a support ~~for bearing~~ designed to bear against a ~~leg~~ hoof of the animal and against the ground; and

an enclosure ~~for enclosing~~ designed to enclose at least part of the ~~leg~~ hoof of the animal, said enclosure including a wall means on said support, a tongue on said support movable relative to said wall means, and at least one band of elastic material connected to said tongue and to said wall means."

A review of the amended language will readily show that the only substantive change lies in the change from "leg" to -hoof--. After receipt of the amended claims, the Examiner performed a second search and finally rejected all claims on new grounds, as anticipated by Glass (US 4,174,754), in a Final Action dated June 10, 2005. The applicant appealed the rejection and filed his Appeal Brief on October 26, 2005.

Upon review of the case on appeal, the Examiner withdrew the case from appeal, performed a third search, and again finally rejected all claims (including Claim 18) on new grounds, as anticipated by Adam (US 840,892), in a Final Action dated January 10, 2006.

As mentioned above, the applicant requested reconsideration of the finality of the rejection, which was maintained, and then filed a petition for review by the Director, which was denied.

For the reasons stated below, the applicant respectfully requests a review of the Director's decision.

ARGUMENT

MPEP Section 706.07(a) provides that, a "second or any subsequent action on the merits shall be made final, except where the Examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment" (Emphasis Added) The section goes on to state, "[A] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." (Emphasis Added)

In the First Office Action, Claim 18 of this application was rejected as indefinite and as anticipated by Dallmer and Kos, as mentioned above. In response, the claim was amended to overcome the Section 112 rejection by deleting the word "means," and by

changing the words "bearing" and "enclosing" to --designed to bear-
- and --designed to enclose--. The claim was also amended to
specify that the invention was directed to a "hoofed" animal,
rather than just an animal, and to recite a --hoof-- instead of a
"leg," consistent with the specification and drawings describing
the horse boot of the invention.

Inasmuch as the Dallmer reference discloses a boot for the hoof of
a horse, it is clear that this change to Claim 18 was not made to
distinguish this reference, as further evidenced by the fact that
the Remarks in reply to the First Office Action do not in any way
refer to the changed language ("hoof") as a distinguishing feature.
Since the Dallmer reference already describes a boot for the hoof
of a horse, it could not have been distinguished by limiting the
claim to a hoofed animal.

With regard to the Kos reference, it discloses an overshoe for the
foot of a woman. Original Claim 18 recited "an enclosure for
enclosing at least part of the leg of the animal..."; therefore,
the original language already distinguished this reference and the
amendment, which was made to more clearly define the invention, was
nonetheless still not necessary. The fact that the applicant
pointed out in his response that Kos did not anticipate the amended

language does not mean that the amendment was made to distinguish the reference. Even if that were the case, though, the fact remains that the Dallmer reference already disclosed a boot for a hoofed animal; therefore, a subsequent search to uncover prior art describing a hoofed animal was not necessitated by the amendment.

In view of the foregoing, it is respectfully submitted that the first search by the Examiner had already been directed to a boot for a hoofed animal and, therefore, this amendment to Claim 18 did not necessitate a new search. Accordingly, the finality of the second action was premature under the first-prong exception of the guidelines provided by MPEP Section 706.07(a).

In the Decision denying the applicant's Petition for Review, the Director relies on MPEP Sect. 904.03 to support the Examiner's position. In particular, the Director relies on the following language, "Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept." (Emphasis Added) Since the applicant did not initially include a claim directed to a "hoofed" animal, and since one of the references applied to Claim 18 (Kos) did not concern a hoofed animal, the Director found support in this

language for maintaining the finality of the Examiner's subsequent action. The applicant respectfully disagrees on two counts.

First, the quoted language is not mandatory (it states "can," not "must"); therefore, it cannot in itself be the basis for a rule that the addition of a limitation not initially recited in a claim automatically requires a final action. If that were the case, the language of MPEP Section 706.07(a) relied upon by the applicant would have no meaning or reason to exist. Such a rule could be applied hard and fast, and the PTO may have decided to do so, but it would be inconsistent with the exceptions provided by its own procedures.

The second, more telling reason for the applicant's disagreement with the Director's basis for the Decision on his Petition is the language immediately preceding the sentence quoted above from MPEP Sect. 904.03. That language states, "[I]t is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into the applicant's amendment." (Emphasis Added) The Examiner in fact followed this rule to the extent that Dallmer discloses a boot

for a hoofed animal, a horse, which is the invention disclosed throughout the applicant's specification. Therefore, a search for a hoofed animal had already been conducted. Accordingly, it is respectfully submitted that the Director's opinion is inconsistent with the very same language quoted in support of the Director's Decision.

As a separate and additional basis for the applicant's position under MPEP Sect. 706.07(a), it is noted that his invention deals only with a horse boot; i.e., a hoofed animal. Therefore, the amendment to Claim 18 made to change "leg" to -hoof-- should reasonably have been expected to be made (especially if needed to overcome prior art). Thus, the second-prong exception of the guidelines provided by MPEP Section 706.07(a) is also believed to apply.

Section 706.07(a) refers to MPEP Section 904 *et seq.* for further guidance. This section states:

"The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference

which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed.

It should not be extended merely to add immaterial variants."

(Emphasis Added)

It is respectfully submitted that the first search conducted with respect to original Claim 18, in view of the specification of the invention (which is solely descriptive of a boot for the hoof of a horse), was performed squarely within the search requirements of MPEP Section 904. Thus, pursuant to the first sentence quoted above, the Glass and Adam patents produced by the second and third searches (which also describe horse boots) should have been referenced after the first search; or, if referenced later, they should not be used as the basis for a final rejection unless their citation was necessitated by an amendment that rendered it necessary, which is clearly not the case here because the only added limitation (a horse boot for a "hoofed" animal) was already disclosed by the first reference (Dallmer).

It is respectfully submitted that the original search should have covered a boot for the hoof of horse, and indeed it did. A new search should not have been required - and in fact it was not, as evidenced by the fact that the second reference (Glass) was apparently found to be cumulative when the Examiner withdrew the case from appeal. The same applies to the third search, which produced another horse reference (Adam), which, if not cumulative, should clearly have been applied (or at least referenced) in the first action. (Neither Glass nor Adams was referenced in the first action; otherwise, the applicant would agree that the finality of the subsequent two actions would have been proper.)

The applicant in this case amended Claim 18 once. To the extent that a substantive amendment was made, it was not presented to distinguish the art cited against it (neither Dallmer nor Kos required the amendment). The amendment reflected an inventive concept toward which the original claim clearly appeared to be directed (see MPEP Section 904) and it recited a disclosed feature that might reasonably be expected to be claimed (see MPEP Section 904.02). Therefore, it is respectfully submitted that the present case falls squarely within the factual situation for which the MPEP proscribes the issuance of a final action.

Contrary to the requirements of PTO procedure, the Examiner performed a second search for new art (Glass), which the applicant had to overcome by filing an appeal. The Examiner then performed a third search for yet another reference (Adam) which is clearly within the scope of the "inventive concepts toward which the claims appear[ed] to be directed," namely a horse boot. Nevertheless, the Examiner again finally rejected Claim 18, once more leaving the applicant no alternative but to follow, for the second time, the time-consuming and expensive process of filing an appeal.

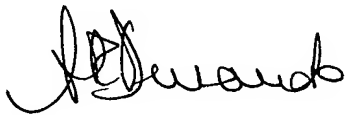
As stated in his Petition to the Director, the applicant is unable to find anything in the Regulations or MPEP supporting such a piecemeal approach to patent prosecution. If permitted, such an approach to searches and rejections would render the search requirements of Section 904 and the finality exceptions of Section 706.07(a) meaningless. This and similar issues have been of great concern to the undersigned and to other members of the Patent Bar who, during the last several years, have experienced an unusual number of office actions that they considered arbitrary and contrary to stated procedures. While compliance with the Office's actions is generally understood among practitioners to be the most expedient and acceptable way to prosecute a case, this Petition is being submitted mainly to gain an understanding of current PTO procedures, which appear to have changed in a material way without

corresponding modifications to the MPEP. Therefore, a clarifying treatment of the issues involved in this Petition would be greatly appreciated.

In view of the various requirements of the MPEP cited above, it is respectfully submitted that the finality of the second and third office actions in this case were premature. Accordingly, the applicant respectfully requests reconsideration of the Examiner's position and the Director's decision.

Please charge any cost associated with this response to our Deposit Account No. 04-1935.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Antonio R. Durando', with a stylized, cursive script.

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